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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SEFCHECK, GREGORY B	
ART UNIT	**PAPER NUMBER**
2662	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/697,395	KOSKINEN ET AL.	
	Examiner	Art Unit	
	Gregory B. Sefcheck	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-22 and 24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 10-22, and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

- Applicant's Amendment filed 7/8/2005 is acknowledged
- Claims 1-7, 11-15, 17, 18, and 20 have been amended.
- Claims 9 and 23 have been cancelled.
- Claim 24 has been newly added.
- Claims 1-8, 10-22, and 24 remain pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claims 1 and 3,

Claim 1 states that "the setting up of the message maintaining the data transmission connection is started in the terminal". Claim 3 then states "starting the setting up of said message for maintaining the data transmission connection in the application server". These claimed statements appear to be contradictory in reference to the "starting" of the setting up of the message.

- Claims 2, 4-8, and 10 are rejected because they depend from claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-8, 10-14, 16-19, 21-22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Frid et al. (US006560239B1), hereafter Frid.

- In regards to Claim 1, 2, 8, 10, 11, 16, 18, 21, 22, and 24

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal (Title; Abstract; Col. 4, lines 33-52; claim 1,11,18,24 – first connection is a packet connection and second connection is a circuit-switched connection; claim 10,16,22 – terminal is a wireless terminal and network is a mobile communication network).

Referring to Fig. 3, Frid shows establishing a packet data connection between a terminal and a packet-switched network, including negotiating a communications protocol with a peer, such as a server associated with an Internet Service Provider or ISP (302-310; Col. 5, lines 20-30; claim 1,11,18,24 – means for establishing data

connection between application server of network and terminal using packet data service as bearer).

Frid further shows establishing a circuit-switched connection between the terminal and the network (312-316; claim 1,11,18,24 – means for establishing circuit-switched connection between network and terminal).

Frid shows that the terminal sends a message (318) for interrupting the packet data connection, but maintaining the connection protocol communication with the server, while accepting the circuit-switched connection (320-336; claim 1,11,18,24 – means for interrupting the packet data connection for the time of the circuit-switched connection; claim 1,11,18,24 – means for setting up a message for maintaining the packet data connection in connection with setting up of the circuit-switched connection; claim 1,11,18,24 – means for automatically starting the setting up of the message maintaining the packet data connection in the terminal; claim 2 – message for maintaining the packet data connection is generated in the terminal and transmitted from the terminal to the server of the network; claim 8,21 – maintenance message is supplemented with a "no operation" command).

- In regards to Claim 3 (as best understood) and 13,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.

Frid shows that the network maintains the parameters of the packet data connection (claim 3,13 – message for maintaining the PPP parameters of the packet data connection is set up at the peer – server – to which the terminal is connected) following receiving an acceptance message from the terminal for the circuit-switched connection (Fig. 3, 318-322; Col. 7, lines 32-65; claim 3,13 – sending information about interrupting the packet data connection from the terminal to the network).

- In regards to Claim 4 and 14,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.

Referring to Fig. 3, Frid shows that the method and terminal receives a message requesting to set up a circuit-switched connection (316; claim 4,14 – means to receive message to setup circuit-switched connection at the terminal).

Frid further shows that the acceptance of the circuit-switched connection (324) is transmitted from the terminal to the network after the maintenance information for the packet data connection is transmitted (318-320; claim 4,14 – means for transmitting reply message to the request for the circuit-switched connection from terminal to network after the message for maintaining the packet data connection is transmitted).

- In regards to Claim 6, 7, and 19,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.4

Frid shows that the packet data connection may communicate information between the network and a termination endpoint, such as the Internet or a server on a LAN (Col. 1, lines 27-35; Col. 5, lines 20-30; claim 6,7,19 – network communicates with a LAN/Internet; claim 6,7,19 – packet data connection is between terminal and server in LAN/Internet)

When the circuit-switched connection is accepted and the maintenance of the packet data connection is set up, the maintenance message is received at the termination endpoint (Fig. 3, 318-322; Col. 7, lines 57-65; claim 6,7,19 – network transmits maintenance message to server/Internet).

- In regards to Claim 12,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.

Frid shows that the terminal is equipped to generate and transmit a message to the network indicating that the packet data connection is to be maintained during a circuit-switched connection (Fig. 3, 318-322; Col. 7, lines 18-55; claim 12 – means for generating and means for transmitting the message for maintaining the packet data connection).

- In regards to Claim 17,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.

Frid discloses a terminal that comprises circuitry for processing (processor; claim 17 – terminal comprises a data processor) messages for the retention of a packet data connection for the duration of a circuit-switched connection (Fig. 3, 318-322; Col. 11, lines 6-31; claim 17 – means for setting up message for maintaining the packet data connection are arranged in the data processor).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frid in view of Chen et al. (US006198945B1), hereafter Chen.

- In regards to Claim 5, 15 and 20,

Frid discloses a method, system, terminal, and software implementation for retaining a packet data (first) connection in a wireless system during a circuit-switched (second) connection to the wireless terminal that covers all limitations of the parent claims.

Frid does not explicitly show selecting and adding a telephone number to the message for setting up the circuit-switched connection. Frid also does not show transmitting the maintenance message for the packet data connection after selecting the telephone number but before setting up the circuit-switched connection.

Chen discloses a method and system that enables a mobile terminal to place a first connection on hold while initiating a second connection by selecting a telephone number and adding that number to a message for setting up a second connection (Fig. 3, Col. 6, lines 15-63; claim 5,15,20 – means to select and add a telephone number to message for setting up the second connection; claim 5,15,20 – message maintaining

the packet data connection is transmitted after the selection of a telephone number, before setting up the circuit-switched connection)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method, system, and terminal of Frid by selecting a telephone number for setting up the circuit-switched connection before maintaining the packet data connection and setting up the circuit-switched connection, as shown by Chen. This modification would allow a packet data connection to be maintained during either an incoming or an outgoing circuit-switched connection.

Response to Arguments

7. Applicant's arguments filed 7/8/2005 have been fully considered but they are not persuasive.

- In the Remarks on pgs. 11-12 of the Amendment, the Applicant contends that Frid does not disclose a data transmission connection between a terminal and an application server, nor the subsequent interruption and maintenance message exchanges of the independent claims. Applicant further contends that Frid addresses the problem but it is admitted that the solution of Frid does not work if the connection has been timed out on the server side.

- The Examiner respectfully disagrees. In the rejection of the independent claims above, in response to Applicant's claim amendments, it is shown that Frid does, in fact, disclose a connection between the terminal and a server in the network which facilitates an ISP application. Lines 20-30 of column 5 in Frid clearly state that a computer communication protocol, such as PPP, is negotiated between the terminal and a peer, such as a server associated with an Internet Service Provider for providing the terminal access to Internet applications. The signaling process of Fig. 3, which details the subsequent interruption and maintenance message exchanges, continues with regard to that terminal-server connection. Frid, therefore, properly meets the limitations of the independent claims as amended.

- In the Remarks on pg. 13 of the Amendment, the Applicant contends that there is no motivation to combine Chen with Frid because Chen discusses only circuit switched call signaling and does not mention a data connection.
- The Examiner respectfully disagrees. Chen and Frid are analogous because they both pertain to call signaling in a communications network. Chen is not required to disclose a data connection in order to disclose the claim limitations that are not explicitly shown by Frid. Those limitations involve the call signaling for setting up of a circuit-switched call. Therefore, the teachings of Chen are applicable to aspects of the circuit-switched connection setup in Frid.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory B. Sefcheck whose telephone number is 571-272-3098. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GBS
9-21-2005

JOHN PEZZLO
PRIMARY EXAMINER